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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/041,416	03/12/1998	ALFONS SCHUSTER	4100-98DIV	3098

7590

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EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/041,416

Applicant(s)

SCHUSTER ET AL.

Examiner

Stephen R Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 20-22 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-18, 20-22 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 10, 12 - 14, 20, 22, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle (EP 099,264) in view of Raschke et al. (US 3,921,527) and Calabrese et al. (US 4,705,696).

Doyle teaches the method as recited with exception of "charging the printing form", applying "liquid" toner particles, and "erasing" the fixed toner particles after a printing process. Note that Doyle teaches on page 4 to electrostatically charge the toner to retain it on the form, as opposed to charging the form.

Raschke et al. teach the conventionality of charging the entire printing form, applying toner to the entire surface of the printing form, using the printing form in a printing process, and erasing the fixed toner particles with a solvent after the printing process. See the Abstract, column 3 lines 56 - 68, and column 5 lines 1 - 9 and 39 - 44 of Raschke et al.

Calabrese et al. teach the conventionality of applying and fixing liquid toner particles to a printing form. See the entire document of Calabrese et al.

It would have been obvious to one of ordinary skill in the art to provide the method of Doyle with the step of charging the printing form as an alternative to charging the toner and erasing the fixed toner to reuse the printing form in view of Raschke et al. and provide liquid toner particles in view of Calabrese et al. teaching the conventionality of such. The step of

controlling the thickness of the toner would have been readily apparent to one skilled in the art. Note column 5 lines 57 - 66 of Calabrese et al., for example. With respect to claims 3 - 6 see column 3 lines 43 - 65 of Raschke et al., for example. With respect to claims 7 - 9 see the paragraph bridging pages 5 and 6 of Doyle, for example. With respect to claim 10 see page 6 lines 11 - 14 of Doyle. With respect to claim 12 see page 7 lines 13 - 16 of Doyle. With respect to claims 13 and 14 see page 6 lines 27 - 31 of Doyle. With respect to claim 22 it would have been obvious to one of ordinary skill in the art to supplement the solvent erasing step of Raschke et al. with a brush or cloth to facilitate removal of the fixed toner particles. With respect to claim 29 it would have been obvious to one of ordinary skill in the art to print with a negative or a positive of the image.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Back (US 3,607,255). Back teaches the conventionality of hydrophilizing the regions not covered by the toner. See the Abstract of Back, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of hydrophilizing the regions not covered by toner in view of Back so as to provide an adequately hydrophilic surface on the printing plate.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Chu et al. (US 4,103,616). Chu et al. teaches the conventionality of crosslinking toner particles with UV radiation. See column 3 lines 2 - 23 of Chu et al. It is noted that lamps,

including mercury, are conventional sources of UV radiation. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of crosslinking the toner particles with UV radiation in view of Chu et al. as an alternative to melting the toner particles with infrared radiation.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Peterson (US 4,020,762). Peterson teaches the conventionality of using a light source to ablate a carbon material from a printing plate. Carbon is a conventional material in toners. See column 1 lines 35 - 50 of Peterson. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of ablating the toner in view of Peterson as an alternative toner removing step.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Raschke et al. and Calabrese et al. as applied to the claims above, and further in view of Tomanek (US 3,650,797). Tomanek teaches the conventionality of removing toner from a printing plate with an alkaline solution. See the Abstract of Tomanek, for example. It would have been obvious to one of ordinary skill in the art to provide the method of Doyle, as modified by Raschke et al. and Calabrese et al., with the step of removing the fixed toner with an alkaline solution in view of Tomanek as a well known alternative solvent.

Applicant's arguments filed May 14, 2003 have been fully considered but they are not persuasive. Applicant's amendments and arguments are not effective to remove the decision by the Board of Patent Appeals and Interferences rendered on October 17, 2002 since the

amendments to claim 1 are clearly taught by Raschke et al. See M.P.E.P. § 706.03(w). With respect to applicant's arguments bridging pages 4 and 5 in the Remarks note the embodiment in Figure 4 of Raschke et al. and that Raschke et al. is relied upon to teach charging the printing form and erasing the printing form.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

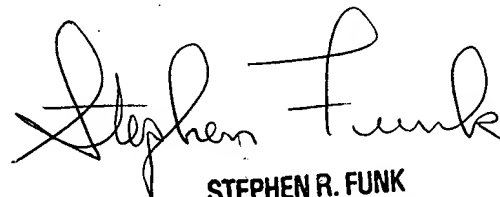
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk
June 25, 2003



**STEPHEN R. FUNK
PRIMARY EXAMINER**